

CENTRAL FAX CENTER

Docket JP920000426US1

DEC 28 2006

Appl. No.: 09/892,147
Filed: June 26, 2001**REMARKS**

This is a reply to Examiner's Office communication of September 28, 2006. Claims 4-7, 9, 14-17, 19, 21, and 22 are pending in the application. Claims 4-7, 9, 14-17, 19, 21, and 22, stand rejected under 35 U.S.C. 102(e) as being anticipated by Esposito et al (hereinafter Esposito) US 6, 587, 838.

Applicant herein amends claims 21 and 22 to make it more clear that the present invention is not anticipated by an arrangement, as claimed, in which there is offering of a hosting service that is offering *merely one* of the claimed hosting service steps.

Applicant gratefully acknowledges that the present Office action was not made final, which presents the opportunity to move the case forward more efficiently. However, the Esposito reference relied upon for the rejection is complex and describes inventions other than that claimed by Applicant. While Applicant thanks the Examiner for indicating which specific parts of the reference are relied upon for the rejections, Applicant regrets that the Office action does not explain the *pertinence* of the specific parts of the reference. Applicant herein makes an effort to clearly and fully respond to the rejections and distinguish the invention over the reference. However, without information about pertinence of the specific parts, Applicants effort is impeded.

"The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." MPEP 706. The examination shall be complete with respect to the patentability of the invention as claimed. 37 CFR 1.104(a)(1). Proper patent examining requires that when a reference relied upon for a rejection is complex the Office action must indicate the particular part relied on, as nearly as practicable, and must explain the reference's pertinence, if it is not apparent. MPEP 706, citing 37 CFR 1.104 Nature of examination ("... When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."). Applicant submits that at least for the following reasons the pertinence of the Esposito reference is not apparent and the examination is not complete with respect to the patentability of the invention as claimed.

Docket JP920000426US1

Appl. No.: 09/892,147
Filed: June 26, 2001

The present Office action divides claim 21 in the present application into six segments, where segment 1 has approximately 75 words, segment 2 has approximately 69 words, segment 3 has approximately 70 words, segment 4 has approximately 126 words, segment 5 has approximately 124 words, and segment 6 has approximately 37 words. In rejecting this claim, the Office action relies upon a single set of passages having a total of 1600+ words, i.e., citing the same set of passages once for each of the above six claim segments. In other words, regarding the pertinence of the cited reference to one 75 word segment of claim 21, for example, the Office action points out parts of the reference that have a combined total of more than 1600 words in length. Applicant submits that on its face this indicates the pertinence of the Esposito reference is not apparent and the examination is not complete with respect to the patentability of the invention as claimed.

Further, this same 1600+ part of the reference is pointed out in the present Office action for the rejection of each and every claim. Overall, this same set of 1600+ words is pointed out approximately 22 times in the second Office action. Further, no other parts of the reference are pointed out except in the Office action's closing response, which appears to be in reply to Applicant's closing arguments in Reply A. In closing arguments in Reply A, Applicant particularly points out three novel features, in which the first feature is stated in 49 words, the second feature is stated in 23 words, and the third feature is stated in 36 words. In response, the second Office action sets out the wording (essentially verbatim) of an additional passage from the reference of over 340 words that were not previously cited. The Office action offers no specific explanation for the significance of this particular newly cited passage. Applicant submits that on its face this indicates the pertinence of the Esposito reference is not apparent and the examination is not complete with respect to the patentability of the invention as claimed.

In addition, this same 1600+ part of the reference was pointed out in the first Office action for each and every claim rejection, i.e., before Applicant submitted the new claim 21, which states the bounds of the invention much more narrowly than did the originally submitted independent claims. Applicant submits that on its face this indicates the pertinence of the Esposito reference is not apparent and the examination is not complete with respect to the patentability of the invention as claimed.

Docket JP920000426US1

Appl. No.: 09/892,147

Filed: June 26, 2001

Based on the above, Applicant submits that the rejections in the current Office action are improper and respectfully requests that if the amended claims set out herein are not allowed, the current Office action be withdrawn and a new Office Action be issued properly setting out the specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific parts*.

Applicant requests a telephone interview and allowance, verbal guidance or a new, nonfinal Office action

Applicant herein submits a request for telephone interview to either i) receive assurance that the amended claims set out herein are to be allowed, ii) receive verbal guidance as to Examiner's position regarding each of the following specific questions, or iii) receive assurance the current Office action will be withdrawn and a new Office Action be issued properly setting out the specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific parts*, in a manner responsive to each of the following questions.

Background regarding request:

Claim 21 in the present application, as herein amended, sets out a method for offering hosting services, that includes steps of a) hosting a plurality of applications on a host computer system at a data center, and b) offering to customers a selection of hosting services [which relate to the above mentioned *applications*, as is clearly set out in the claim], wherein the customers may select from among first, second third, fourth, fifth and sixth hosting service steps for performance by the host computer system.

Claim 21 goes on to state that hosting the plurality of applications on a host computer system at a data center includes:

“executing an application for a first *shopping process* on the data center host computer system, the first shopping process being accessible to shoppers by Internet communications wherein the first shopping process performs . . . a first hosting service step”

and includes:

Docket JP920000426US1

Appl. No.: 09/892,147

Filed: June 26, 2001

"executing an application for a second *resource planning process* on the data center host computer system, wherein the second resource planning process performs . . . a second hosting service step"

and includes:

"executing an application for a second *integration process* on the data center host computer system, wherein the second integration process performs . . . a third hosting service step . . . a fourth hosting service step . . . a fifth hosting service step . . . and . . . a sixth hosting service step."

If no allowance is granted, Applicant requests the following specific questions be addressed in a telephone interview or in a new Office action:

Regarding the first hosting service step, the claim specifically states that a first shopping process on a data center host computer system and that is accessible to shoppers by Internet communications, communicates with a *first integration process* and a *first resource planning process* via Internet communications to transact first sales. The claim also states that the first resource planning process is on a computer system *host located remotely from the data center*. The claim also states the first integration process is on a host computer system located remotely from the data center.

What specific process taught by Esposito does the rejection rely upon for the claimed first shopping process that is on a data center host computer system and that is accessible to shoppers by Internet communications and that communicates with a *first integration process* and a *first resource planning process* via Internet communications to transact first sales?

Note that claim also states that the claimed first integration process is on a *host computer system located remotely* from the data center. What specific process taught by Esposito does the rejection rely upon for the claimed *first integration process*? What specific host computer system taught by Esposito does the rejection rely upon for this *remotely located host computer system*?

Note that the claim also states that the claimed first resource planning process is on a *host computer system located remotely* from the data center. What specific process taught by Esposito

Docket JP920000426US1

Appl. No.: 09/892,147
Filed: June 26, 2001

does the rejection rely upon for the claimed *first resource planning process*? What specific host computer system taught by Esposita does the rejection rely upon for this *remotely located host*?

Regarding the second hosting service step, the claim specifically states that a *second resource planning process* on the data center host computer system communicates with a *production process* via Internet or dedicated link communications.

What specific process taught by Esposita does the rejection rely upon for the claimed *second resource planning process* that is on the data center host computer system and that communicates with a production process via Internet or dedicated link communications?

What specific process taught by Esposita does the rejection rely upon for the claimed *production process*?

Note that the claim also states that the production process is on a host computer located remotely from the data center. What specific host computer system taught by Esposita does the rejection rely upon for this *remotely located host*?

Regarding the third hosting service step, the claim specifically states that a *second integration process* on the data center host computer system couples communications between the first shopping process and the second resource planning process to *transact second sales*.

What specific process taught by Esposita does the rejection rely upon for the claimed *second integration process* that is on the data center host computer system and that couples communications between the first shopping process and the second resource planning process to transact second sales?

Regarding the fourth hosting service step, the claim specifically states that Internet communications to *transact third sales* are coupled between the second resource planning process and a *second shopping process* that is accessible to shoppers by Internet communications.

What specific process taught by Esposita does the rejection rely upon for the claimed *second shopping process* that is accessible to shoppers by Internet communications and that communicates with the second resource planning process for transacting third sales?

Docket JP920000426US1

Appl. No.: 09/892,147

Filed: June 26, 2001

Note that the claim also states that the second shopping process is on a *host computer located remotely* from the data center. What specific host computer system taught by Esposita does the rejection rely upon for this *remotely located host*?

Regarding, the fifth hosting service step, the claim specifically states that communications are coupled between the first shopping process and a *third resource planning process* to transact fourth sales.

What specific process taught by Esposita does the rejection rely upon for the claimed *third resource planning process*?

Note that the claim also states that the third resource planning process is on a *host computer located remotely* from the data center. What specific host computer system taught by Esposita does the rejection rely upon for this *remotely located host*?

Regarding the sixth hosting service step, the claim specifically states that communications are coupled between a certain process and a *third shopping process*, that the third shopping process is accessible to shoppers by Internet communications, and that the third shopping process is on a host computer *located remotely* from the data center .

What specific process taught by Esposita does the rejection rely upon for the claimed *certain process* that is coupled to the third shopping process?

Note that the claim also states that the certain process is on a host computer *located remotely* from the data center. What specific host computer system taught by Esposita does the rejection rely upon for this *remotely located host*?

What specific process taught by Esposita does the rejection rely upon for the claimed *third shopping process*?

Note that the claim also states that the third shopping process is on a host computer *located remotely* from the data center. What specific host computer system taught by Esposita does the rejection rely upon for this *remotely located host*?

Docket JP920000426US1

Appl. No.: 09/892,147
Filed: June 26, 2001

Applicant reiterates that the invention as claimed is not taught or suggested by the art of record.

It is notable that claim 21 of the present application recites *both a host computer at a data center and a host computer remote from the data center*. Further, the claim specifically states that the data center computer hosts applications, that this includes processes on the data center host performing a specifically recited set of six *hosting service steps*. As herein amended, the claim further recites offering to *customers* a selection of hosting services, wherein the customers may select from among the six hosting service steps for performance by the host computer system. Also in the context of some of these claimed hosting service steps, the claim recites communications between processes to *transact sales*, some of which are specifically recited as being on the data center host and some of which are specifically recited as being on the remote host. The claim also recites that two of the processes are shopping processes, one of which the claim recites is on the data center host, one of which the claim recites is on the remote host, and each of which the claim recites is accessible to *shoppers* by Internet communications.

It does not appear Esposito teaches what is claimed even according to the above very general description of what is claimed. Applicant is unable even to find any suggestion by Esposito of both a host at a data center and a host at a remote location.

Also, in claim 21 of the present case there are both *customers*, who are offered services for hosting shopping processes, and there are *shoppers*, who access those processes, which transact sales. There no suggestion by Esposito of customers who are different than shoppers. It appears Esposito uses the term *customers* interchangeably with the term *users*, although the use of "customers" throughout Esposito is generally limited to reference to a "customer database," whereas Esposito tends to refer to "users" in the context of purchases and selections of products or services. Clearly Esposito refers to users who select products or service listed in a vendor computer database or make purchase requests. Esposito, e.g., col. 2, line 33; col. 3, line 62-64; claim 1. There is no suggestion by Esposito of offering to customers a selection of hosting services, wherein the customers may select from among the six hosting service steps for performance by the host computer system, and wherein in the context of some of the hosting service steps there are also *shoppers*, as claimed in the present case. That is, in the context of some of the hosting service steps there are communications between *processes to transact sales*

Docket JP920000426US1

DEC 28 2006

Appl. No.: 09/892,147
Filed: June 26, 2001

and two of the processes are shopping processes, one of which the claim recites is on the data center host, one of which the claim recites is on the remote host, and each of which the claim recites is accessible to *shoppers* by Internet communications.

For at least these reasons, Applicant submits that claim 21 is patentably distinct. Claim 22 has similar language, according to the form of the invention it claims. Therefore, Applicant submits that claim 22 is likewise patentably distinct. Claims 4-7, 9, 14-17 and 19 are allowable at least because they depend on allowable claims 21 or 22.

REQUESTED ACTIONS

For the reasons explained herein above, Applicant contends that the claims as amended herein are patentably distinct and hereby requests that Examiner grant allowance and prompt passage of the application to issuance.

In addition, as stated herein above, Applicant herein submits a request for telephone interview to either i) receive assurance that the amended claims set out herein are to be allowed, ii) receive verbal guidance as to Examiner's position regarding each of the following specific questions, or iii) receive assurance the current Office action will be withdrawn and a new Office Action be issued properly setting out the specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific parts*, in a manner responsive to each of the following questions.

Respectfully submitted,



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Attachment: Applicants Written Request for Interview

PTOL-413A (08-04)
Approved for use through 07/31/2008. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form JP92000426US1

Application No.: 09/892,147 First Named Applicant: Shamirakov
Examiner: Clement B Graham Art Unit: 3628 Status of Application: _____

Tentative Participants:

(1) Ex. Graham (2) Examiner's supervisor
(3) Anthony England (4) _____

Proposed Date of Interview: Jan 25, 2006

Proposed Time: 11:00 (AM/PM)

Type of Interview Requested:

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES

☐ NO

If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior	Discussed	Agreed	Not Agreed
(1) <u>Rej.</u>	<u>21</u>	<u>Exposito</u>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/> Continuation Sheet Attached			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

Brief Description of Arguments to be Presented:

Applicant requests answers to the 17 questions set out in Reply B, pages 11-13

An interview was conducted on the above-identified application on _____.

NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Anthony VS England
Applicant/Applicant's Representative Signature

Examiner/SPE Signature

ANTHONY VS ENGLAND
Typed/Printed Name of Applicant or Representative

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Registration Number, if applicable

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This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.